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EXAMINER
POKRZYWA, JOSEPH R

ART UNIT	PAPER NUMBER
2622	19

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/575,139	LAPSTUN ET AL.	
	Examiner	Art Unit	
	Joseph R. Pokrzywa	2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 May 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *25-49* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *25-49* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on May 9, 2003, and has been entered and made of record. Currently, **claims 25-49** are pending.

Response to Arguments

2. Applicant's arguments filed May 9, 2003 have been fully considered but they are not persuasive.

3. In response to applicant's arguments regarding the rejection of **claims 25, 28-30, 32, 33, 36, 37, 39, and 41-45**, as cited in the Office action dated February 5, 2003, as being anticipated by Merchant *et al.* (U.S. Patent Number 5,581,366), stating on page 6 that the examiner has not clearly and explicitly specified the correspondence between claimed features and equivalent features alleged to be shown by the citations. Upon review of Merchant, the examiner believes that one of ordinary skill in the art can still interpret Merchant as teaching each of the features. Because of this, the rejection, as cited in the Office action dated 2/5/03, will be maintained, and repeated in this action, and will be fully discussed below.

4. Particularly, on pages 7-10 of applicant's arguments, the applicant discusses how Merchant lacks teaching of the limitations of claim 25. Specifically, applicant begins on page 7, stating that Merchant fails to teach of "utilizing a form printed onto at least one surface". The examiner notes that according to Merriam Webster's Collegiate Dictionary 10th edition, the word "print" has one definition which states "to display on a surface (as a computer screen) for

viewing". Therefore, the limitation of "utilizing a form printed onto at least one surface" can be seen as the form displayed on the display screen 50 at the sending SCR 12 or displayed at the receiving SCR 40, as read in column 5, lines 43 through 64. Further, Merchant teaches that the form includes information relating to the user (heading portion 106, column 4, lines 21 through 23) and at least one area for the user to enter a message (message box 102, column 4, lines 16 and 17), with the at least one surface (display 50) having coded data (with the coded data being "bubbles" for spelling out a numeric code, as read in column 4, lines 16 through 21) indicative of an identity of the form (whereby as seen in Fig. 6, the "bubbles" are indicative of a fax form) and of the at least one area (pager pin number block 104, which is "printed" on the display screen 50, as read in column 4, lines 55 through 67). It is further noted that the recitation of the above limitations has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

5. Continuing, Merchant provides the form to the user, as read in the discussion in column 4, lines 25 through 54, whereby software in SCR provides the form, being the template, to the user to fill in. Next, Merchant teaches of receiving, in a computer system, interaction data from a sensing device used to compose the message (column 4, lines 38 through 67, wherein a user utilizes pen input device 60 to write a message by touching the display screen 50, which then activates pixels displayed on the display screen 50, as read in column 3, lines 7 through 14,

whereby "touching" is considered to be one of the senses, thus the pen input device can be interpreted as a sensing device), with the interaction data being indicative of an identity of the form and a position of the sensing device relative to the area (column 4, line 55 through column 5, line 8). Continuing Merchant teaches that the sensing device (pen input device 60), when placed operatively relative to the area in order to compose the message (column 4, line 55 through column 5, line 8), generating the interaction data based at least partially on sensing at least some of the coded data in the vicinity of the position (column 4, line 16 through column 5, line 8, seen as steps 200-206 in Fig. 7), capturing electronically, in the computer system and from the interaction data, at least the message (step 208 in Fig. 7, column 5, lines 1 through 8), and transmitting the message to a designated recipient address for facsimile delivery (step 210 in Fig. 7, column 5, lines 9 through 36). With this, one of ordinary skill in the art can clearly interpret claim 25, as well as claim 36 as being anticipated by Merchant.

6. Therefore, the rejection of independent **claim 25**, as well as independent **claim 36**, as cited in the Office action dated 2/5/03, under 35 U.S.C. 102(b), as being anticipated by Merchant *et al.*, is maintained and repeated in this Office action.

7. Continuing, the examiner will discuss each of the dependent claims that were rejected under 35 U.S.C. 102(b), as being anticipated by Merchant *et al.* Regarding the rejection of ***claims 28 and 29***, the applicant argues on page 13 that Merchant fails to teach of the provided number being valid only for a predetermined time, and fails to teach of a user able to indicate whether a reply number is to be transmitted with the message. Merchant teaches the message is delivered with a reply number for sending a return message, and that the reply number is valid

for a predetermined time only, as read in column 4, lines 15 through 67, wherein the reply number would be valid only until the next message is sent and received, which is a predetermined time. Further, Merchant also teaches in the same section cited above that a sender indicates on the form, using the sending device, whether a reply number is to be transmitted with the message, whereby the user would fill in the form, inserting a reply number when it is to be transmitted with a message. Regarding the rejection of ***claims 32 and 33***, applicant argues on page 13 that Merchant fails is not logically possible for any sensing device to move relative to the form, since the form is displayed on the tablet. The examiner notes that the form is interpreted as the printed form on the display screen (50), and the sensing device (pen stylus input device 60) moves relative to the form, whereby the computer system receives the movement data, as read in column 4, line 55 through column 5, line 8.

8. Therefore, the rejection of dependent **claims 28-30, 32, and 33**, as well as dependent **claims 37, 39, and 41-45**, as cited in the Office action dated 2/5/03, under 35 U.S.C. 102(b), as being anticipated by Merchant *et al.*, is maintained and repeated in this Office action.

9. With respect to applicant's arguments regarding the rejection of dependent ***claim 26***, which was cited under 35 U.S.C. 103(a), as being unpatentable over Merchant *et al.* in view of Tanaka (U.S. Patent Number 4,494,862), which states on pages 10-12 that the combination of Merchant and Tanaka is improper since Tanaka is from an entirely different field from Merchant, that there is no reasonable success to combine the references, and that the combination does not result in the claimed invention. In review, Merchant discloses the method discussed above, and further teaches of causing the form to be "displayed" in response to receiving, in the computer

system, a request for the form (column 4, lines 16 through 67). Further, Merchant teaches that the "form itself can take the form of a physical sheet of paper" (as read in column 4, lines 23 through 28). However, Merchant fails to specifically teach of causing the form to be physically **printed** in response to receiving, in the computer system, a request for the form, whereby a printer prints at least the form onto the at least one surface. Tanaka is being relied on to teach this feature. Tanaka discloses a method of enabling composition of a facsimile by a user and delivery thereof (column 11, lines 12 through 21), utilizing a form printed onto at least one surface (column 7, line 52 through column 8, line 61), with the method including the steps of providing the form to the user (column 8, lines 21 through 61). Tanaka further teaches of causing the form to be printed in response to receiving, in the computer system, a request for the form (see Figs. 9, 10, and 13(a)-13(d), column 8, lines 21 through 61), whereby a printer prints the form onto at least one surface (see Fig. 10, column 6, line 65 through column 7, line 2). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Tanaka in the system of Merchant, thereby providing a printer, so as to print information which is then marked by a stylus pen. Merchant's system would easily be modified to incorporate Tanaka's teachings, thereby making the system of Merchant easier to operate using simplified operations, as recognized by Tanaka. Tanaka, although performing different operations than that of Merchant, as recognized by applicant, teaches that a form is printed, and information from the form is read using a pen stylus. Because of this, one of ordinary skill in the art can clearly recognize that the features that Merchant lacks are taught and utilized by Tanaka, and would easily be included in Merchant's system, thereby making use of

simple, routine operations, as noted by Tanaka. Thus, the combination of Merchant and Tanaka is deemed proper, and the rejection is maintained.

10. In response to applicant's arguments with respect to the rejection of dependent ***claim 27***, cited as being unpatentable over Merchant *et al.* in view of Tanaka, wherein applicant's state on pages 12 and 13, that no coded data is "printed" simultaneously with the form onto a surface. As discussed above, Merchant teaches of causing the form to be "displayed" simultaneously with the coded data (column 4, lines 16 through 67), but fails to specifically teach of physically **printing** the form and coded data. Tanaka teaches this feature, as discussed above, which would easily be included in Merchant's system, thereby making use of simple, routine operations, as noted by Tanaka. Thus, the combination of Merchant and Tanaka is deemed proper, and the rejection is maintained.

11. In response to applicant's arguments with respect to the rejection of dependent ***claim 34***, cited as being unpatentable over Merchant *et al.* in view of Tanaka, wherein applicant's state on page 14, that Merchant does not disclose the use of coded data as defined in the claims, thereby making any combination with a reference that does use such coded data as not obvious and improper. With the discussion above, Merchant teaches that the coded data is interpreted as the "bubbles" for spelling out a numeric code, as read in column 4, lines 16 through 21. However, Merchant fails to teach if the coded data is substantially invisible to the average unaided human eye. Tanaka discloses a method of enabling composition of a facsimile by a user and delivery thereof (column 11, lines 12 through 21), utilizing a form printed onto at least one surface (column 7, line 52 through column 8, line 61), with the method including the steps of providing the form to the user (column 8, lines 21 through 61). Tanaka further teaches of a stylus input

device that is a marking fluorescent pen which is invisible to the average unaided human eye and wherein marking marks from the fluorescent pen are detected by color mark sensor 22 (column 9, lines 25 through 36, and column 12, lines 56 through 60). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of using a fluorescent pen for invisible coded data in Tanaka to the system of Merchant since Merchant also teaches the use of a pen for generating coded data for fax message. Thus, the combination of Merchant and Tanaka is deemed proper, and the rejection is maintained.

12. Therefore, the rejection of dependent **claims 26, 27, 34, 38, 46, 48, and 49**, as cited in the Office action dated 2/5/03, under 35 U.S.C. 103(a), as being unpatentable over Merchant *et al.* in view of Tanaka, is maintained and repeated in this Office action.

13. In response to applicant's arguments with respect to the rejection of dependent ***claim 35***, cited as being unpatentable over Merchant *et al.*, wherein applicant's state on page 14, that Merchant does not disclose saving a copy of sent faxes. The examiner notes that this limitation is not specifically claimed. While, Merchant does not directly teach that the recipient address is selected from a document provided with an address list, and the system and method includes a retrievable record of each form printed using at least some of the coded data on the surface on which the form is printed, it was commonly known in the art that the recipient address is selected from an address list and the form is stored in a memory for retrieval. Merchant teaches of an address memory (address memory 72, Fig. 3) for storing a plurality of addresses or a list of addresses, and an image memory (message memory 16, Fig. 1) for storing the form to be used. It would have been obvious to a person of ordinary skill in the art at the time the invention was

made to consider that the address memory 72 in Merchant stores a list of address wherein an address can be selected, and the image memory 16 in Merchant stores the fax form to be retrieved as a matter of being well known in the prior art.

14. Therefore, the rejection of dependent **claims 31 and 35**, as cited in the Office action dated 2/5/03, under 35 U.S.C. 103(a), as being unpatentable over Merchant *et al.*, is maintained and repeated in this Office action.

Claim Objections

15. **Claims 26, 27, 33, and 37-49** are objected to because of the following informalities:

Regarding ***claim 26***, in line 1, "claim 1" should read "claim 25";

Regarding ***claim 27***, in line 1, "claim 1 or claim 2" should read "claim 25 or claim 26";

Regarding ***claim 33***, in line 1, "claim 8" should read "claim 32";

Regarding ***claim 37***, in line 1, "claim 12" should read "claim 36";

Regarding ***claim 38***, in line 1, "claim 12 or claim 13" should read "claim 36 or claim 37";

Regarding ***claim 39***, in line 1, "claims 12 to 14" should read "claims 36 to 38";

Regarding ***claim 40***, in line 1, "claim 15" should read "claim 39";

Regarding ***claim 41***, in line 1, "claim 15 or claim 16" should read "claim 39 or claim 40";

Regarding ***claim 42***, in line 1, "claims 12 to 17" should read "claims 36 to 41";

Regarding ***claim 43***, in line 1, "claims 12 to 18" should read "claims 36 to 42";

Regarding ***claim 44***, in line 1, "claim 19" should read "claim 43";

Regarding ***claim 45***, in line 1, "claim 19 or claim 20" should read "claim 43 or claim 44";

Regarding ***claim 46***, in line 1, "claims 12 to 21" should read "claims 36 to 45";

Regarding ***claim 47***, in line 1, "claims 12 to 22" should read "claims 36 to 46";

Regarding ***claim 48***, in line 1, "claims 12 to 23" should read "claims 36 to 47;

Regarding ***claim 49***, in line 1, "claim 24" should read "claim 24";

Appropriate correction is required.

Claim Rejections - 35 USC § 102

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

17. **Claims 25, 28-30, 32, 33, 36, 37, 39, 41-45** are rejected under 35 U.S.C. 102(b) as being anticipated by Merchant *et al.* (U.S. Patent Number 5,581,366, cited in the Office action dated 2/5/03).

Regarding ***claim 25***, Merchant discloses a method of enabling composition of a facsimile by a user and delivery thereof (see abstract), utilizing a form printed onto at least one surface (being the form represented in Fig. 6, whereby the form is displayed on the display screen 50 at the sending SCR 12 or is displayed at the receiving SCR 40, as read in column 5, lines 43 through 64), the form including information relating to the user (heading portion 106, column 4, lines 21 through 23) and at least one area for the user to enter a message (message box 102, column 4, lines 16 and 17), the at least one surface (display 50) having coded data (with the coded data being "bubbles" for spelling out a numeric code, as read in column 4, lines 16 through 21) indicative of an identity of the form (whereby as seen in Fig. 6, the "bubbles" are

indicative of a fax form) and of the at least one area (pager pin number block 104, which is "printed" on the display screen 50, as read in column 4, lines 55 through 67), with the method including the steps of providing the form to the user (being the form represented in Fig. 6, as read in column 4, lines 25 through 54, whereby software in SCR provides the form, being the template, to the user to fill in), receiving, in a computer system, interaction data from a sensing device used to compose the message (column 4, lines 29 through 67, wherein a user utilizes pen input device 60 to write a message by touching the display screen 50, which then activates pixels displayed on the display screen 50, as read in column 3, lines 7 through 14, whereby "touching" is considered to be one of the senses, thus the pen input device can be interpreted as a sensing device), the interaction data being indicative of an identity of the form and a position of the sensing device relative to the area (column 4, line 55 through column 5, line 8), the sensing device, when placed operatively relative to the area in order to compose the message (column 4, line 55 through column 5, line 8), generating the interaction data based at least partially on sensing at least some of the coded data in the vicinity of the position (column 4, line 16 through column 5, line 8, seen as steps 200-206 in Fig. 7), capturing electronically, in the computer system and from the interaction data, at least the message (step 208 in Fig. 7, column 5, lines 1 through 8), and transmitting the message to a designated recipient address for facsimile delivery (step 210 in Fig. 7, column 5, lines 9 through 36).

Regarding ***claim 28***, Merchant discloses the method discussed in any of the preceding claims, and further teaches that the message is delivered with a reply number for sending a return message, the reply number being valid for a predetermined time only (column 4, lines 15 through

67, wherein the reply number would be valid until the next message is sent and received, which is a predetermined time).

Regarding ***claim 29***, Merchant discloses the method discussed in any of the preceding claims, and further teaches of a sender of the message indicates on the form, using the sending device, whether a reply number is to be transmitted with the message (column 4, lines 15 through 67, wherein the user would fill in the form, inserting a reply number when it is to be transmitted with a message).

Regarding ***claim 30***, Merchant discloses the method discussed in any of the preceding claims, and further teaches that the recipient address is entered on the form in writing, using the sensing device, and the writing is electronically captured and converted into digital form to facilitate transmission of the message (column 4, lines 15 through 67).

Regarding ***claim 32***, Merchant discloses the method discussed in any of the preceding claims, and further teaches of receiving, in the computer system, movement data regarding movement of the sensing device relative to the form (column 4, line 55 through column 5, line 8).

Regarding ***claim 33***, Merchant discloses the method discussed above in claim 32 (as understood by the examiner), and further teaches that the sensing device generates the movement data using at least some of the coded data (column 4, line 55 through column 5, line 8).

Regarding ***claim 36***, Merchant discloses a system to enable a user to compose and deliver a message by facsimile (see abstract), utilizing a form printed onto at least one surface (being the form represented in Fig. 6, whereby the form is displayed on the display screen 50 at the sending SCR 12 or is displayed at the receiving SCR 40, as read in column 5, lines 43 through 64), the

form including information relating to the user (heading portion 106, column 4, lines 21 through 23) and at least one area for the user to enter a message (message box 102, column 4, lines 16 and 17), the at least one surface (display 50) having coded data (with the coded data being "bubbles" for spelling out a numeric code, as read in column 4, lines 16 through 21) indicative of an identity of the form (whereby as seen in Fig. 6, the "bubbles" are indicative of a fax form) and of the at least one area (pager pin number block 104, which is "printed" on the display screen 50, as read in column 4, lines 55 through 67), with the system including a computer system which causes the form to be provided to the user (being the form represented in Fig. 6, as read in column 4, lines 25 through 54, whereby software in SCR provides the form, being the template, to the user to fill in), receives the interaction data from a sensing device used to compose the message (column 4, lines 29 through 67, wherein a user utilizes pen input device 60 to write a message by touching the display screen 50, which then activates pixels displayed on the display screen 50, as read in column 3, lines 7 through 14, whereby "touching" is considered to be one of the senses, thus the pen input device can be interpreted as a sensing device), the interaction data being indicative of an identity of the form and a position of the sensing device relative to the area (column 4, line 55 through column 5, line 8), the sensing device, when placed operatively relative to the area in order to compose the message (column 4, line 55 through column 5, line 8), generating the interaction data based at least partially on sensing at least some of the coded data in the vicinity of the position (column 4, line 16 through column 5, line 8, seen as steps 200-206 in Fig. 7), and captures the message (step 208 in Fig. 7, column 5, lines 1 through 8) to be transmitted to a designated recipient address by facsimile delivery (step 210 in Fig. 7, column 5, lines 9 through 36).

Regarding ***claim 37***, Merchant discloses the system discussed in above in claim 36 (as understood by the examiner), and further teaches that the computer system causes the form to be provided to the user in response to receiving a request for the form (column 4, line 29 through column 5, line 8).

Regarding ***claim 39***, Merchant discloses the system discussed above in claim 36 (as understood by the examiner), and further teaches that the computer system is adapted to deliver the message with a reply number, valid for a predetermined time only (column 4, lines 15 through 67).

Regarding ***claim 41***, Merchant discloses the system discussed in above in claim 39 (as understood by the examiner), and further teaches that the computer system includes the reply number dependent upon a sender's instruction, indicated by interaction of the sensing device with an appropriate user interactive element on the form (column 4, lines 15 through 67).

Regarding ***claim 42***, Merchant discloses the system discussed in above in claim 36 (as understood by the examiner), and further teaches that the computer system is adapted to retrieve movement data regarding movement of the sensing device relative to the form, in order to capture the message (column 3, lines 7 through 14, and column 4, lines 15 through 67).

Regarding ***claim 43***, Merchant discloses the system discussed in above in claim 36 (as understood by the examiner), and further includes the sensing device (column 3, lines 7 through 14, and column 4, lines 15 through 67).

Regarding ***claim 44***, Merchant discloses the system discussed in above in claim 43 (as understood by the examiner), and further teaches that the sensing device includes a marking nib (column 3, lines 7 through 14, and column 4, lines 15 through 67).

Regarding ***claim 45***, Merchant discloses the system discussed in above in claim 43 (as understood by the examiner), and further teaches that the sensing device generates the movement data using at least some of the coded data (column 3, lines 7 through 14, and column 4, lines 15 through 67).

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

19. **Claims 26, 27, 34, 38, 46, 48, and 49** are rejected under 35 U.S.C. 103(a) as being unpatentable over Merchant *et al.* (U.S. Patent Number 5,581,366, cited in the Office action dated 2/5/03) in view of Tanaka (U.S. Patent Number 4,494,862, cited in the Office action dated 2/5/03).

Regarding ***claims 26 and 48***, Merchant discloses the method discussed in above in claim 25 (as understood by the examiner), and the system discussed above in claim 36 (as understood by the examiner), and further teaches of causing the form to be "displayed" in response to receiving, in the computer system, a request for the form (column 4, lines 16 through 67). Further, Merchant teaches that the "form itself can take the form of a physical sheet of paper" (as read in column 4, lines 23 through 28). However, Merchant fails to specifically teach of causing the form to be physically **printed** in response to receiving, in the computer system, a request for the form, whereby a printer prints at least the form onto the at least one surface. Tanaka discloses

a method of enabling composition of a facsimile by a user and delivery thereof (column 11, lines 12 through 21), utilizing a form printed onto at least one surface (column 7, line 52 through column 8, line 61), with the method including the steps of providing the form to the user (column 8, lines 21 through 61). Tanaka further teaches of causing the form to be printed in response to receiving, in the computer system, a request for the form (see Figs. 9, 10, and 13(a)-13(d), column 8, lines 21 through 61), whereby a printer prints the form onto at least one surface (see Fig. 10, column 6, line 65 through column 7, line 2). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Tanaka in the system of Merchant, thereby providing a printer, so as to print information which is then marked by a stylus pen. Merchant's system would easily be modified to incorporate Tanaka's teachings, thereby making the system of Merchant easier to operate using simplified operations, as recognized by Tanaka.

Regarding ***claim 49***, Merchant and Tanaka disclose the system discussed in above in claim 48 (as understood by the examiner), and it was commonly known in the art to have a printer include a means for binding the printed form in the event the form includes a plurality of pages. Tanaka supports this by disclosing a computerizing information processing system capable of printing a form with coded data input from stylus simultaneously (Figs. 9 and 10), and the system in Tanaka can print a plurality of copies wherein binding can be performed. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of printing a form with stylus input information simultaneously and the binding of a plurality of pages in Tanaka to the system of Merchant,

since the system of Merchant is a facsimile machine which can transmit and receive fax messages, wherein it was commonly known in the art that the received message can be printed.

Regarding ***claims 27 and 38***, Merchant and Tanaka disclose the method and system discussed above in claims 26 and 36 (as understood by the examiner), and Tanaka further teaches of causing the form and the coded data to be printed onto the at least one surface substantially simultaneously (see Figs. 9, 10, and 13(a)-13(d), column 8, lines 21 through 61). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Tanaka in the system of Merchant, thereby providing a printer, so as to print information which is then marked by a stylus pen. Merchant's system would easily be modified to incorporate Tanaka's teachings, thereby making the system of Merchant easier to operate using simplified operations, as recognized by Tanaka.

Regarding ***claims 34 and 46***, Merchant fails to teach that the coded data is substantially invisible to the average unaided human eye. Tanaka discloses a method of enabling composition of a facsimile by a user and delivery thereof (column 11, lines 12 through 21), utilizing a form printed onto at least one surface (column 7, line 52 through column 8, line 61), with the method including the steps of providing the form to the user (column 8, lines 21 through 61). Tanaka further teaches of a stylus input device that is a marking fluorescent pen which is invisible to the average unaided human eye and wherein marking marks from the fluorescent pen are detected by color mark sensor 22 (column 9, lines 25 through 36, and column 12, lines 56 through 60). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of using a fluorescent pen for invisible coded data

in Tanaka to the system of Merchant since Merchant also teaches the use of a pen for generating coded data for fax message.

20. **Claims 31 and 35** are rejected under 35 U.S.C. 103(a) as being unpatentable over Merchant *et al.* (U.S. Patent Number 5,581,366, cited in the Office action dated 2/5/03).

Regarding ***claims 31 and 35***, Merchant does not directly teach that the recipient address is selected from a document provided with an address list, and the system and method includes a retrievable record of each form printed using at least some of the coded data on the surface on which the form is printed. However, it was commonly known in the art that the recipient address is selected from an address list and the form is stored in a memory for retrieval. Merchant teaches of an address memory (address memory 72, Fig. 3) for storing a plurality of addresses or a list of addresses, and an image memory (message memory 16, Fig. 1) for storing the form to be used. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to consider that the address memory 72 in Merchant stores a list of address wherein an address can be selected, and the image memory 16 in Merchant stores the fax form to be retrieved as a matter of being well known in the prior art.

21. **Claims 40 and 47** are rejected under 35 U.S.C. 103(a) as being unpatentable over Merchant *et al.* (U.S. Patent Number 5,581,366, cited in the Office action dated 2/5/03) in view of Baran (U.S. Patent Number 5,247,591, cited in the Office action dated 2/5/03).

Regarding ***claims 40 and 47***, Merchant fails to teach that the fax message is transmitted to a fax server and the system includes a database for keeping a retrievable record of each form

printed. Baran discloses a method and apparatus for routing fax messages using hand printed characters to a fax server (Fig. 8, 208, Fig. 10) including a database (196, Fig. 8). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of transmission to and reception of fax message from a fax server and a database for keeping retrieval record in Baran to the system n Merchant since both Merchant and Baran teach fax device which can transmit a sheet form with information relating the routing of the fax message and handwritten information on the form as a fax message to remote fax machines.

Conclusion

22. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

J. R. P.

Joseph R. Pokrzywa
Examiner
Art Unit 2622

jrp
July 23, 2003

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